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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/749,332	12/30/2003	Daniel F. Justin	13447.42	9889
7590 01/09/2008				
DANA L. TANGREN WORKMAN NYDEGGER 1000 EAGLE GATE TOWER 60 EAST SOUTH TEMPLE SALT LAKE CITY, UT 84111		EXAMINER SWIGER III, JAMES L		
		ART UNIT PAPER NUMBER		
		3733		
		MAIL DATE DELIVERY MODE		
		01/09/2008 PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/749,332

Applicant(s)

JUSTIN ET AL.

Examiner

James L. Swiger

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 08 October 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-8, 10-20 and 30-43 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8, 10-20 and 30-43 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 November 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 10/12/2007.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Claim Objections***

Claim 12 is objected to because of the following informalities: In line 9, it is suggested that the word "begin" be amended to state --being--. Appropriate correction is required.

### ***Information Disclosure Statement***

It is noted that the inventor name is improperly identified with regards to US Patent 5,346,496. The proper inventor is Pennig, not Penning. No action is necessary, as it was considered as admitted, relevant prior art based on the Document number and publication date.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 6-7, and 42-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bourque (US Patent 5,163,940) in view of Pennig (US Patent 5,346,496). Bourque discloses a guide assembly for a tibia having a brace (22) having a first and second ends (see Fig. 2), a template on the first end (28) of the brace, and a tubular guide sleeve (78/32) on the second end of the brace (that is considered substantially U-shaped--a wide "u"--) that is capable of being selectively biased against

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a lateral, medial, or anterior side of a tibia if a surgeon wishes to do so and has a distal end (74). The template also comprises a base plate portion (87) with a projection at the end (86) that is positioned to catch or be associated with the end of the tibia. It may also be "biased" depending on the intended use during surgery. Bourque also disclose markings (76) and a central longitudinal axis (36).

Bourque discloses the claimed invention except for wherein the template is movable in a linear fashion. Pennig discloses a first end of a brace (9) that is movable linearly at an end. Note that 8' is considered the point at which a sleeve could contact via a longitudinal axis two different locations, since the end of the brace (9) moves the entire templated portion (8') between at least a first and second locations. It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the device of Bourque having at least a templated end portion that is capable of movement between a first and second locations with respect to the longitudinal axis of the sleeve of Bourque to better arrange the device with respect to the various anatomies of a patient.

Claims 12-16, 18, 30-36, 38, and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bourque (US Patent 5,163,940). Bourque discloses the claimed device except for template have a low profile and that essentially has a paddle-like shape, a protrusion and a constricted stem portion for fitting into the guide assembly. These modifications are substantially considered obvious shape modifications. It is well known in the art to have various shapes that would conform to

the anatomy where it will be used that a person of ordinary skill in the art would find obvious for the purpose of providing a better fit for the guide assembly in use. In re Dailey and Eilers, 149 USPQ 47 (1966).

Claims 4-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bourque (US Patent 5,163,940) and Pennig. Bourque and Pennig discloses the claimed device except for template have a low profile and that essentially has a paddle-like shape, a protrusion and a constricted stem portion for fitting into the guide assembly. These modifications are substantially considered obvious shape modifications. It is well known in the art to have various shapes that would conform to the anatomy where it will be used that a person of ordinary skill in the art would find obvious for the purpose of providing a better fit for the guide assembly in use. In re Dailey and Eilers, 149 USPQ 47 (1966).

Claims 8, 17 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bourque '940 in view of Purnell et al. (US Patent 4,781,182), and Bourque '940 in view of Pennig '496 for claim 8. Bourque [and Pennig] disclose the claimed invention except for a plurality of alternative templates. Purnell et al. disclose a plurality of templates (Fig. 2) so that the device can be used for a plurality of uses (Col. 6, lines 37-45). It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the device of Bourque and [Pennig] having at least a plurality of templates in view of Purnell et al. to better use the device for use on the tibia.

Claims 10, 19 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable

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over Bourque in view of Ko (US Patent 5,354,302), and Bourque and Pennig for claims 10. Bourque [and Pennig] disclose the claimed invention except for a plurality of teeth formed at the end of the guide sleeve. Ko discloses teeth (22a-d) and Fig. 2 that allow instruments to access the specified area better (see C ol. 5, lines 46-58). It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the device of Bourque [and Pennig] having at least teeth at the end of the guide sleeve in view of Ko to allow better access to the tissue area for instruments.

Claims 11, 20 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bourque in view of Chan (US Patent 6,120,511) and Bourque and Pennig for claim 11. Bourque discloses the claimed invention except for a tubular drill sleeve within the guide sleeve and a guide wire. Chan discloses (refer to Fig. 14) a tubular drill sleeve (48) that is within the guide sleeve (82) and has a guidewire (52) see Col. 2, lines 12-45). It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the device of Bourque having at least a tubular drill sleeve and a guide wire in view of Chan to better bore into the tibia, as guided by the device.

### ***Response to Arguments***

Applicant's arguments with respect to claims 1-8, 10-20 and 30-43 have been considered but are moot in view of the new ground(s) of rejection.

Applicant's arguments filed 10/8/2007 have been fully considered but they are not persuasive. With regards to the claim amendments, it is noted that the structure has been rejected under the prior art of record.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James L. Swiger whose telephone number is 571-272-5557. The examiner can normally be reached on Monday through Friday, 9:00am to 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

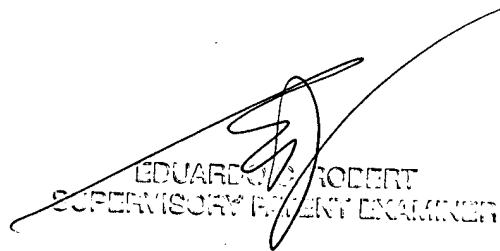
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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



1/6/08

JLS



EDUARDO ROBERT  
SUPERVISORY PATENT EXAMINER